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REMARKS

This is a full and timely response to the final Office Action of August 23, 2006. Reconsideration and allowance of the application and all presently pending claims are respectfully requested.

Upon entry of this Response, claims 1, 3-4, 6-11, 18-21, and 38 are pending in this application. Claims 1, 3, 7, 9, and 18 have been amended. Claims 2, 5, 11-17, and 22-37 are canceled without prejudice, waiver, or disclaimer. The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims. Applicants believe that no new matter has been added and that a new search is not necessary.

CLAIMSClaim 1 and Dependent Claims

Claim 1 and its dependent claims are rejected under 35 U.S.C. §103 as purportedly being made obvious by Zhou *et al.* (Nat. Biotech., 2001, 19, 375-378) in view of Mercader *et al.* (Anal. Biochem., 2002, 308, 269-277), Holmes (U.S. Patent 5,679,773), Fields *et al.* (Proc. Natl. Acad. Sci., 1988, 85, 1384-1388), Oda *et al.* (Nat. Biotech., 2001, 19, 379-382), as described in more detail in the Office Action.

Applicants traverse all of the assertions and rejections in the Office Action and submit that the rejections of claim 1 and its dependent claims under 35 U.S.C. §103 in view of Zhou, Mercader, Holmes, Fields, and Oda, individually or in combination, should be withdrawn because each do not disclose, teach, or suggest at least some of the highlighted portions and combinations of the highlighted portion in amended claim 1 above. In particular, Zhou, Mercader, Holmes, Fields, and Oda, individually or in combination, do not disclose, teach, or suggest, that "non-magnetic first resin," as recited in claim 1. In addition, Zhou, Mercader, Holmes, Fields, and Oda, individually or in combination, do not disclose, teach, or suggest the combination of elements in claim 1 because one skilled in the art would not be motivated to do so and one skilled in the art would not expect to successfully make such a combination.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The

Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

In the present case, there is no suggestion or motivation to combine the references to make the modifications proposed in the Office Action. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP § 2143.01.

It has often been noted that, "[h]umans must work with old elements, most if not all of which will normally be found somewhere in an examination of the prior art." *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1549, 220 U.S.P.Q. 193 (Fed. Cir. 1983). Furthermore, that features, even distinguishing features, are "disclosed" in the prior art is alone insufficient. As indicated above, it is common to find elements or features somewhere in the prior art. Moreover, most if not all elements perform their ordained and expected function. The test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Id.*

In this regard, Applicants note that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest *both* the combination of elements *and* the structure resulting from the combination. *Stiftung v. Renishaw PLC*, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements.

Applicants respectfully submit that there is no proper motivation, suggestion, or other teaching that would lead a person of ordinary skill in the art to combine Zhou, Mercader,

Holmes, Fields, and Oda such as to render obvious the claim 1. It is not reasonable for the Office to assert that one skilled in the art would look at 4 or 5 references to selectively cull features to render claim 1 obvious. As mentioned above, "[h]umans must work with old elements, most if not all of which will normally be found somewhere in an examination of the prior art." One skilled in the art would not be motivated to combine 4 or 5 references and selectively cull features from each reference to render claim 1 obvious. The Office Action is making its determination of obviousness based on hindsight combination of the selectively culled features from numerous references.

Given the lack of a suggestion or motivation contained in the prior art for the proposed modification, it appears that the only suggestion or motivation comes from Applicant's own disclosure. As is well established in the law, such hindsight to the Applicant's own disclosure is per se improper. See *Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002) (a determination of obviousness cannot be based on a hindsight combination of components selectively culled from the prior art to fit the parameters of the invention).

In addition, one skilled in the art would not have an expectation of success by combining select features from 4 or 5 references to render claim 1 obvious. The chemical and biological arts are *uncertain* and one skilled in the art would not have an expectation of successfully combining a large number of selectively culled features from 4 or 5 references. Mere hindsight combination of the selectively culled features would not provide one skilled in the art with an expectation of success.

Therefore the rejection to claim 1 should be withdrawn.

Claims 3-4 and 6-11

Applicants respectfully submit that pending dependent claims 3-4 and 6-11 include every feature of independent claim 1 and that each of the references fails to disclose, teach, or suggest, individually or in combination, at least the features of claim 1. Thus, pending dependent claims 3-4 and 6-11 are also allowable over the prior art of record. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

New Claim 38 and Dependent Claims

Applicant note that Zhou, Mercader, Holmes, Fields, and Oda, individually or in combination, do not disclose, teach, or suggest, the combination of features as recited in claim

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38. In particular, Zhou, Mercader, Holmes, Fields, and Oda, individually or in combination, do not disclose, teach, or suggest the combination of elements in claim 38 because one skilled in the art would not be motivated to selectively cull features from 4 or 5 references. In addition, one skilled in the art would not expect to successfully make such a combination by selectively cull features from 4 or 5 references.

Claims 18-21

Applicants respectfully submit that pending dependent claims 18-21 include every feature of independent claim 38 and that each of the references fails to disclose, teach, or suggest, individually or in combination, at least the features of claim 38. Thus, pending dependent claims 18-21 are also allowable over the prior art of record.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

In addition, any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted ,

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